

Notice of Allowability

Application No.

10/685,199

Applicant(s)

PETRY ET AL.

Examiner

Janet L. Coppins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Applicants' amendment of 9/26/06.
2. ☒ The allowed claim(s) is/are 1-13.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

1. Claims 1-13 are pending in the instant application.

Claim Rejections - 35 USC § 102

2. Claims 1-4 previously rejected under 35 U.S.C. 102(b) as being anticipated by Simons et al, Research Development Journal, and Simons et al, U.S. Pat. 4,255,510 and U.S. Pat. 4,256,881. In view of Applicants' amendatory changes, the anticipation rejections have been obviated and are withdrawn from the claims.

Claim Objections

3. Claims 5-8 were previously objected to as being dependent upon a rejected base claim. In view of Applicants' amendments, the objections are herein withdrawn.

EXAMINER'S AMENDMENT

4. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Irving Newman, Reg. No. 22,638 on December 20, 2006.

The application has been amended as follows:

- (a) Claim 10, line 1, please delete the term "medicament" and replace with "pharmaceutical composition".
- (b) Claim 11, line 1, after the term "HSL," please insert the phrase, "for treating a disease selected from the group consisting of non-insulin-dependent diabetes mellitus, diabetes

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syndrome, or syndrome X". Also in Claim 11, line 2, please delete the term "medicament" and replace with "pharmaceutical composition".

(c) Claim 12, line 3, please delete the term "medicament" and replace with "pharmaceutical composition".

REASONS FOR ALLOWANCE

5. In view of Applicant's amendatory changes, claims 1-13 are allowable over the prior art. The following is an examiner's statement of reasons for allowance:

This invention relates to novel benzotriazole-carbonyl-piperidine compounds, their derivatives, their pharmaceutical compositions, and their methods of use. The allowable compounds are limited to compounds according to formula I of claim 1. Certain benzotriazole compounds are known in the art as having the ability to inhibit the activity of lipase, however the aspect of preparing the instant claimed benzotriazole-carbonyl-piperidine derivatives, with HSL inhibitory activity, is novel and unobvious. The instant compounds were tested for selective inhibition of HSL enzymatic activity (please refer to inhibitory results, IC₅₀ values, etc. found in pages 27-30 of the specification), which makes them useful for treating diabetes, for example. After a thorough search, the closest of prior art, U.S. Pat. No. 4,255,510 and 4,256,881, to Simon et al. was found to teach similar triazole compounds. However the above-mentioned patents fail to teach or render obvious the instant claimed compounds according to formula (I), and do not fairly suggest methods of using the instant claimed compounds as HSL inhibitors for treating diabetes, etc.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

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fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Telephone Inquiry

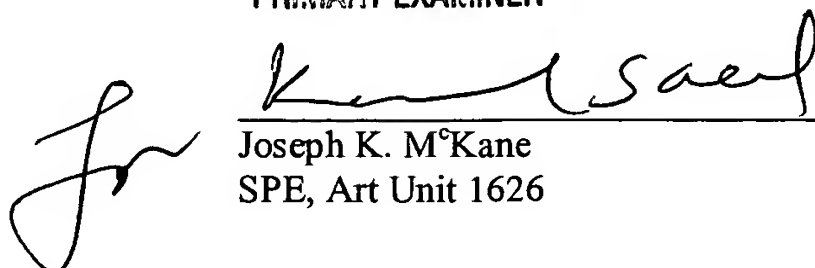
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Coppins whose telephone number is 571.272.0680. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571.272.0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Janet L. Coppins
December 20, 2006

KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER


Joseph K. McKane
SPE, Art Unit 1626